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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional):

4541-004/RSW9-99-089

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Date: **March 29, 2006**

Signature:

Typed or printed name: **KATHLEEN KOPPEN**

Application Number:

09/458,410

Filed:

December 10, 1999

First Named Inventor:

Peyravian

Art Unit:

2131

Examiner:

ARAVIND K. MOORTHY

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor

Signature

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

(Form PTO/SB/96)

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Registration Number if acting under 37 CFR 1.34 _____

March 29, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ form(s) is/are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Peyravian et al.

Serial No.: **09/458,410**

Filed: **December 10, 1999**

For: **Time Stamping Method Employing
Multiple Receipts Linked by a Nonce**

Docket No: **4541-004**

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)
) **PATENT PENDING**

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) **Examiner: Aravind K. Moorthy**

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) **Group Art Unit: 2131**

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) **Confirmation No.:8813**
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March 29, 2006

Date

Kathleen Koppen
Kathleen Koppen

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants submit the following remarks in support of the Pre-Appeal Brief Request for Review attached herewith. Claims 1-19 are currently pending and are finally rejected under 35 U.S.C. §102(b) as being anticipated by Haber (WO 92/03000). Independent claims 1 and 9 both contain language that calls out first and second different receipts. The first receipt includes data identifying a document received by an outside agency (e.g., a hash) and the second includes a time indication that indicates when the agency received the identifying data. Thus, both the first and second receipts are related to the same document and the same time-stamping transaction.

Haber does not create two different receipts related to the same document as required by the claims, but rather creates a single receipt associated with a single document. Haber then concatenates that single receipt with another previously created time-stamp receipt. Notably,

however, this previously created time-stamp receipt was created in response to a completely different and unrelated transaction.

Each receipt created in Haber contains a hash (H_k) of a document (D_k), the ID of the author (ID_k), a sequential receipt number (r_k), and a time indication (t_k) that indicates when the TSA processed the receipt. *Haber*, p. 14, ln. 10 – p. 15, ln. 1. Thus, each single receipt for a given document D_k contains both the identifying data and a time indication. The Examiner asserts that Haber creates the two claimed receipts; however, this is non-sensical in the Haber context. Indeed, there is no need for Haber to create a second receipt to include information (i.e., the time indication) already contained in the first receipt.

Nevertheless, the Examiner cites pages 16-17 to support the assertion that Haber does. Scrutiny reveals that this section only contradicts the Examiner's assertion. Haber explicitly discloses that the TSA adds (i.e., concatenates) the data of a previously created receipt D_{k-1} to the current receipt D_k . After adding the data, the receipt created for D_k contains both its own time t_k and the time t_{k-1} of the previously created receipt. *Haber*, p. 16, ll. 3-5. This time indication t_{k-1} does not indicate a time that the TSA received the document D_k as is required by the claims. In contrast, it indicates the time that the TSA processed an earlier document D_{k-1} . Processing D_{k-1} is a different transaction performed on a different document at a different time, and thus, the time indication t_{k-1} is independent of the document D_k currently being processed. It cannot indicate the time that the TSA received document D_k .

Further, Haber necessarily fails to disclose the claimed linking value. The claimed linking value links the first receipt containing the identifying data with the second receipt containing the time that the outside agency received the identifying data. Haber, in contrast, simply creates a composite receipt representing the current transaction and all prior transactions. *Haber*, p. 21, ll. 3-7. According to Haber, the TSA creates a single, composite certificate that includes a composite hash of "the entire history of the TSA time-stamping

operation" concatenated with the current transaction. *Haber*, pg. 21, ll. 14-17 (emphasis added). There is no linking value in *Haber* as required by the claimed invention. Moreover, there is no need for a linking value when each composite receipt created by the TSA includes a composite hash of all prior receipts ever created by the TSA.

Applicants note that the Examiner admitted in earlier Office Actions that another patent to *Haber* failed to disclose the claimed linking value. Particularly, the currently cited *Haber* patent '000 claims priority from two U.S. applications, which have since issued as U.S. Patent Nos. 5,136,646 and 5,136,647. In previous Office Actions, the Examiner cited *Haber* RE 34,954, which is a reissue of the '647 patent. The '646 and '647 patents disclose slightly different methods of forming the time-stamp receipts -- i.e., the '646 patent creates the composite receipt described above, while the '647 patent concatenates previous and current receipts. However, both the '646 and '647 patents create the receipts in substantially the same manner (i.e., to include both the data and a time indication in a single receipt). Applicants successfully overcame this RE 34,954-based §102 rejection thereby forcing the Examiner to withdraw the rejection and admit, "*Haber* is silent in expressly disclosing inserting a linking value into said first and second receipts that links the identifying data in the first receipt with the time indication in the second receipt." *Office Action dated July 2, 2004*, p. 3, 14-16.

In sum, *Haber* does not create the requisite first and second receipts, nor does *Haber* disclose the claimed linking value. Because *Haber* fails to teach each and every element of independent claims 1 and 9, the §102 rejection of claims 1-19 necessarily fails as a matter of law.

The Examiner also rejected claims 1-19 under 35 U.S.C. §112 ¶1 and ¶2, and under 35 U.S.C. §101. Regarding the §112 rejections, the Examiner asserts that the specification fails to support, "receiving identifying data derived from a document at an outside agency." Guided by this assertion, the Examiner then postulates that claims 1 and 9 recite a use without setting forth

any positive steps delineating how the process is actually practiced. *Final Office Action*, p. 3, ¶6. These assertions, and thus, the rejections themselves, are based on the misguided belief that the specification fails to support: 1) that the outside agency of the claims receives the identifying data; and 2) that the identifying data is derived from a document.¹ However, the §112 rejections are without merit and should be withdrawn.

The specification explicitly states, “[t]he hash value H generated on document D or a selected portion thereof is transmitted to and received by the TSA at step 104.” *Spec*, p. 6, lines 4-5; Figure 1 (emphasis added). Thus, the specification unquestionably supports the fact that the outside agency receives the identifying data. Moreover, pages 4 and 5 of the specification and Figure 1 describe one embodiment where a hash function takes a document D (or selected portions thereof) as input, and computes a hash value H from that document. Because the hash value (i.e., output) depends on the document content (i.e., input), the hash value is necessarily derived from the document. These passages and the figure prove that the specification supports the claimed subject matter, and provides reasonable, explicit examples of how one skilled in the art might “derive” identifying data from the document. No one skilled in the art armed with the specification and drawings would need to perform any sort of experimentation – let alone undue experimentation - to practice the claimed invention.

Regarding the §101 rejection, the Examiner’s stated position is that the claims recite a use without setting forth any steps involved in the process. *Final Office Action*, p. 3, ¶17. During the telephone conversation of February 22, 2005, the Examiner stated that the §101 rejection was based on the belief that the specification did not support or explain how the identifying data was derived from the document, and thus, the §101 rejection is related to the §112 ¶1 rejection discussed above. However, as previously noted, this “lack of support” assertion is unfounded.

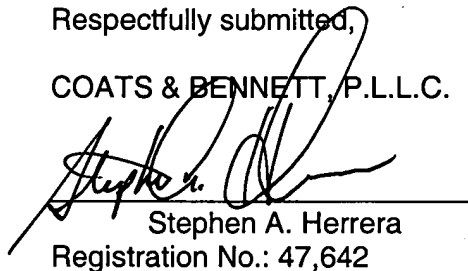
¹ The undersigned agent telephoned the Examiner on or about February 22, 2006 to clarify the reasons for the §112 and §101 rejections. The Examiner stated that both the §112 and the §101 rejections were based on the belief that the specification did not support or explain how the identifying data was “derived” from a document.

Applicant has adequately described "how" the claimed invention is used, and therefore, has necessarily described "what" that invention is. Therefore, Applicant has complied with the requirements of both §112 and §101. The §101 rejection is based on a fundamentally flawed theory and should be withdrawn.

For at least the foregoing reasons, Applicants request the withdrawal of all §112, §101, and §102 rejections, and the allowance of all pending claims.

Respectfully submitted,

COATS & BENNETT, P.L.L.C.

A handwritten signature in black ink, appearing to read "Stephen A. Herrera", is written over a horizontal line. The signature is stylized and cursive.

Dated: March 29, 2006

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